

REMARKS

Claims 1-68 are pending in this application. Claims 7-52 are withdrawn from consideration. Claims 1-6 and 53-68 are rejected. Claims 1, 53, 64 and 67 are independent claims.

In an office action dated December 30, 2003, the examiner rejected claims 1-6 and 53-63 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claims the subject matter that applicants regard as the invention. More specifically, the examiner argues that the PTO position is that "system" and "network" are indefinite without some accompanying structure.

Applicants have amended the independent claims to clarify structure and to avoid the use of vague and indefinite language. No new matter has been added. Accordingly, claims 1-6 and 53-63 are proper under 35 U.S.C. §112, second paragraph.

The examiner uses the CNET news.com article to reject claims 1-6 and 53-68 as having been anticipated. Maintaining a position stated in an earlier office action, the examiner argues that "a rejection under 35 U.S.C. §102/103 can be made when the prior art product seems identical to that of the prior art except that it is silent to an inherent characteristic."

Applicants disagree. In order for a reference to inherently anticipate under §102, following the reference must inevitably produce the claimed subject matter. In re King, 801 F.2d 1324, 231 USPQ 136 (Fed. Cir. 1986). The mere fact that a reference's generically disclosed structure might fortuitously have been built in accordance with the narrower limitations of the claim cannot constitute anticipation. In re Felton (cited by the CCPA in In re Marshall, 578 F.2d 301, 198 USPQ 344 (CCPA 1978)); Tilghman v. Proctor, 102 U.S. 707 (1880); Eibel Process Co. v. Minnesota and Ontario Paper Co., 261 U.S. 45 (1923).

Claim 1, as amended, recites "receiving a message in one of the plurality of networked computer systems for a new quote for a trading item." The CNET news.com article neither describes nor suggests this quoted feature. On the contrary, the CNET news.com article discloses monitoring the market's billions of transactions. Claim 1 recites, "comparing the new quote to one or more existing quotes for the same item in one of the plurality of networked

computer systems.” The CNET news.com article neither describes nor suggests this quoted feature. Claim 1 recites, “transmitting an alert message in one of the plurality of networked computer systems in response to comparing to another one of the plurality of networked computer systems if the new quote causes a locked or crossed market condition.” The CNET news.com article neither describes nor suggests this quoted feature.

Accordingly, claim 1 is not anticipated by the CNET news.com article and the rejection under 35 U.S.C. §102(e) is improper and should be withdrawn.

Claim 53 recites, “in a network of interconnected computer systems, receiving a message in a network server for a new quote for a trading item.” The CNET news.com article neither describes nor suggests this quoted feature. Claim 53 recites, “comparing the new quote to existing quotes for the same trading item in the network server.” The CNET news.com article neither describes nor suggests this quoted feature. Claim 53 recites “generating an alert to one of the interconnected computer systems if the new quote is determined to represent an unusual quote value.” The CNET news.com article neither describes nor suggests this quoted feature.

Accordingly, claim 53 is not anticipated by the CNET news.com article and the rejection under 35 U.S.C. §102(e) is improper and should be withdrawn.

Claim 64 recites, “receive a message for a new quote for a trading item in one of the plurality of networked computer systems.” The CNET news.com article neither describes nor suggests this quoted feature. Claim 64 recites, “compare the new quote to one or more existing quotes for the same item in the one of the plurality of networked computer systems.” The CNET news.com article neither describes nor suggests this quoted feature. Claim 64 recites, “transmit an alert message to another one of the plurality of networked computer systems in response to comparing if the new quote causes a locked or crossed market condition.” The CNET news.com article neither describes nor suggests this quoted feature.

Accordingly, claim 64 is not anticipated by the CNET news.com article and the rejection under 35 U.S.C. §102(e) is improper and should be withdrawn.

Claim 67 recites, “receive a message in a network server for a new quote for a trading item.” The CNET news.com article neither describes nor suggests this quoted feature. Claim 67

recites, "compare the new quote to existing quotes for the same trading in the network server." The CNET news.com article neither describes nor suggests this quoted feature. Claim 67 recites "generate an alert from the network server to one of the plurality of networked computer systems if the new quote is determined to represent an usual unusual quote value." The CNET news.com article neither describes nor suggests this quoted feature.

Accordingly, claim 67 is not anticipated by the CNET news.com article and the rejection under 35 U.S.C. §102(e) is improper and should be withdrawn.

The examiner also uses the CNET news.com article to reject claims 1-6 and 53-68 as having been obvious. As stated above, the examiner argues that "a rejection under 35 U.S.C. §102/103 can be made when the prior art product seems identical to that of the prior art except that it is silent to an inherent characteristic." The examiner's basis for obviousness appears to be inherency.

Applicants disagree. In going from the prior art to the claimed invention one cannot base obviousness upon what a person skilled in the art might try or might find obvious to try but rather must consider what the prior art would have led a person skilled in the art to do.

In a prior office action, the examiner admits that claim 1 fails to teach an alert for a market condition known as "locked or crossed." Claim 1 also recites "receiving a message in one of the plurality of networked computer systems for a new quote for a trading item." This feature is not disclosed, suggested or taught in the CNET news.com article, and thus claim 1, as amended, would not have been obvious from the CNET news.com article. The CNET news.com article only discloses the following and nothing else:

the software monitors the market's billions of transactions and alerts Nasdaq officials to any unusual market activity. (paragraph two)

One skilled in this art recognizes a transaction as an agreement between a buyer and a seller to exchange an asset for payment. This is different from receiving a message in one of the plurality of networked computer systems for a new quote for a trading item. Accordingly, claim 1 is not rendered obvious by the CNET news.com article.

Claims 53, 64 and 67 recite "in a network of interconnected computer systems, receiving a message in a network server for a new quote for a trading item, comparing the new quote to existing quotes for the same trading item in the network server and generating an alert to one of the interconnected computer systems if the new quote is determined to represent a usual an unusual quote value," or similar language. These features are not disclosed, suggested or taught in the CNET news.com article, and thus claims 53, 64 and 67 would not have been obvious from the CNET news.com article.

All of the dependent claims are patentable for at least the same reasons as the claims on which they depend.

It is believed that all of the pending claims have been addressed. However, the absence of a reply to a specific rejection, issue or comment does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

Applicants ask that all claims be allowed. Please apply any charges or credits to deposit account 06-1050.

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Respectfully submitted,

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